

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN
CALIFORNIA,

Opposer,

v.

UNIVERSITY OF SOUTH CAROLINA,

Applicant.

Opposition No. 125,615

Serial No. 75/358,031

Mark: SC (Stylized)

Filed: September 16, 1997

Published: May 18, 1999

REPLY IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT



12-09-2003

U.S. Patent & TMOtc/TM Mail RcptDt. #22

I. California's Moving Evidence Has Not Been Controverted

In the moving papers, California submitted evidence on certain key facts which, if established, would demonstrate that California is entitled to summary judgment against Carolina's attempt to adopt an SC mark for sports merchandise after long using its classic "C" with its Gamecock mascot. Pursuant to the Board's direction that reply briefs not repeat prior argument, California will not reiterate the significance of these facts but will note only that Carolina has not submitted any evidence to controvert the following key facts:

1. Carolina's proposed mark is a subset of California's incontestable SC word-mark.
2. Carolina's proposed mark is confusingly similar to various forms of the SC mark which California has long used.
3. Carolina's proposed mark would be used on the exact same goods on which California uses its mark (including T-Shirts, which are specifically identified on California's current registrations and Carolina's proposed application).
4. Both California's goods and Carolina's goods are offered by the very same brick and mortar retail stores as well as the very same internet stores. Moreover, those goods are sometimes displayed in ways that are confusingly jumbled. [EK ¶ 31.]¹
5. California sells goods under its SC mark across the nation and that it has sold at least \$5-\$10 million dollars in branded goods over the last ten fiscal years. [EK ¶¶ 11, 13, 19-30.]

¹ Carolina did provide evidence that some Internet retailers separate California goods from Carolina goods. [Carolina Brief ("CB") at 10.] The fact that some Internet retailers work to avoid confusion, however, does not eliminate the possibility that other retailers (particularly brick and mortar retailers) will present the goods in a confusing way. Carolina asserts without support that such goods may be sold with other related goods from the same source. [*Id.*] Actually, sporting goods stores more typically sell goods like California's hats with other hats (such as Carolina's) than with other goods from the same source. [Supplemental Declaration of Elizabeth Kennedy ("SEK") ¶ 20.]

II. Carolina's Evidence Is Either Irrelevant, Misleading or Both

Carolina makes various statements during the course of its arguments which are either irrelevant, are not supported by the citations, are not fairly presented, or for which no citation is given. Although many of these points may seem small, the cumulative effect creates a highly misleading presentation, and California will respond to as many as space reasonably permits.

A. Carolina's Attempt To Distinguish Its Mark From California's Common Law Uses Is Disingenuous Since It Ducks the "Baseball Interlock" and Misrepresents the Similarity of the Color Schemes

In its moving papers, California noted that it uses one form of the SC mark called the "Baseball Interlock," consisting of the letter S superimposed over (and interlocked through) the letter C. Not only has California long used that form, but that form of the SC mark was submitted as part of California's statement of use for Federal Registration No. 1,844,953. [Attached for convenience to the Supplement Declaration of Elizabeth Kennedy ("SEK") Ex. A.] Although a side by side comparison of the Baseball Interlock and the proposed Carolina mark shows certain small differences, the marks are virtually identical and would clearly be confusing in the marketplace. Carolina does not respond to the Baseball Interlock at all, preferring instead to try to distinguish only the "SC Interlock." [CB at 4-5.]

Carolina does attempt to distinguish the manner in which the marks are used by contending that California and Carolina have "completely different" color schemes. [CB at 4.] This is disingenuous given the actual colors used by the schools. Carolina notes that it uses "garnet and black" while California uses "cardinal and gold." [*Id.*] But "garnet" and "cardinal" are very similar colors, both more or less a dark red color. [SEK ¶¶10-16 and Exs. D-E.] And both schools frequently use a combination of that dark red along with white and/or black. [*Id.*] The similarity in color schemes only adds to the confusion likely as a result of similar marks. [*Id.*]

B. Carolina Suggests that Carolina Is At Least as "Famous" as California for Its Use of the SC Mark But Provides Only Misleading or Irrelevant Evidence

Although Carolina contends that Carolina is at least as famous as California for its use of the SC mark and that Carolina has used the mark either for "decades" or for almost a hundred years, [CB at 11-13], Carolina's assertions are entirely unsupported.² Despite various general assertions, Carolina presents no evidence that it uses the SC mark as part of its general activities. For example, Carolina contends that its football games are better attended than California's football games. [CB at 11.] However, Carolina carefully does not state that it uses any form of SC mark as part of its football program, because – in contrast to California – Carolina does not actually use any SC mark for its football program. Rather, Carolina's football program uses Carolina's traditional C mark with the Carolina Gamecock mascot in the middle. [See Carolina's Athletic Webpages, attached for the Board's convenience as SEK Ex. F; *see also* Carolina's Sept. 16, 1997 Response to Office Action, identifying SC mark as used in "baseball program."] As such, the attendance at Carolina's football games has no relevance to this dispute. Likewise, Carolina's evidence that it has a higher enrollment than California or more alumni is irrelevant given the lack of any evidence that such students or alumni associate any form of SC mark with Carolina. *See generally In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443, 1450 (TTAB 1994) (significant tool sales were irrelevant unless mark used for such sales).

Carolina's Internet evidence fares no better. Even if this Board were to consider Carolina's evidence about various internet uses despite the lack of any evidentiary foundation, the evidence would show only that the letters "SC" are not uncommonly associated with things

² In addition, even if Carolina had previously used a version of an SC mark in connection with clothing (which is totally unsupported), such use would not entitle Carolina to a registration of a mark that is confusingly similar to California's preexisting and incontestable mark.

in the state of South Carolina. This does not show trademark usage of the SC mark by the University of South Carolina, much less trademark usage on the goods at issue here.

Finally, it should go without saying that the mere fact that Carolina's web address includes the letters "SC" does not qualify as a trademark usage, much less a trademark usage on the goods at issue in this application. *See generally See In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998); TMEP § 1209.03(m) (domain name is not a mark unless identifier of goods or services).

C. Carolina's Conspiracy Theories About Spelman College Are Facially Wrong

1. As a Matter of Record, California Did Not Narrow Its Channels of Trade to Avoid Conflict with Spelman College

Carolina suggests that California somehow nefariously narrowed its channels of trade in registering its SC word-mark after Spelman College submitted several extensions of time in which to oppose, in order to avoid any opposition from Spelman College. The file history of the SC registration conclusively disproves this. California made no change to its application after that application published for registration. Carolina simply willfully ignores the file history in order to attempt to distract this Board.³

2. As a Matter of Record, California Did Not Consent to Any Similar Version of the SC Mark (for Clothing or Otherwise)

Carolina also suggests that California consented to the use of an SC mark by Spelman College, and that California has therefore lost its right to object to any similar mark.

In fact, the Board need look no further than the Spelman College registrations submitted by Carolina itself to see that the Spelman mark is very different. [CB Ex. I.] Unlike the marks at

³ In fact, the channels of trade were narrowed before publication in response to the examiner's concerns about a now-cancelled registration from Snake Creek, whose stylized SC-label was used on some clothing outside of the collegiate market. [SEK ¶ 9.]

issue in this Opposition (which are either typed or stylized marks containing only the letters SC), the Spelman mark is a design mark consisting of a schoolhouse incorporating the letters SC. The fact that California has consented to one "schoolhouse design" including the letters SC (as a portion of the graphic) does not mean that California must allow every other party to use marks that consist of nothing but the letters SC in forms similar to California's own stylized forms.

In addition, the Board can look at those Spelman College registrations to determine that Spelman College does not have any registration in International Class 25 for clothing or otherwise. There is no evidence that California consented to any other mark on clothing, and no reason to believe that might be so.⁴ The Spelman College registrations are simply a red-herring.

D. Carolina's Discussion of 66 "Word Marks" Is Both Wrong and Entirely Irrelevant Since The Cited Marks Are Not Word Marks *And Do Not Apply* to Clothing or Collegiate-Related Goods

Carolina argues that California's SC mark is weak because it contends that there are 66 "word marks" that consist of nothing but the letters SC. [CB at 12, citing Ex. I.] Even if the Board were inclined to consider the evidence submitted as Exhibit I, despite the failure to submit any Notice of Reliance, a review of those registrations will reveal that only a small portion of them are "word marks" as that term is commonly used (*i.e.* a mark registered "in typed form."). Aside from California's own registration, only 11 of identified marks are live registrations in typed form (as well as one abandoned application in typed form). Moreover, aside from California's own registration, none of the typed registrations relates to either clothing or collegiate services, relating instead to entirely dissimilar goods and services (*e.g.* metal aircraft fasteners, hydraulic pumps, polyethyleneimines, *etc.*).

⁴ In fact, California's consent for the Spelman College "SC (and schoolhouse design)" does not include clothing or any goods in Class 25. [SEK ¶ 7 and Ex. B.]

Moreover, most of the remaining registrations cited by Carolina are highly evolved design marks which happen to include the letters SC as components of a larger graphic design. Of the remaining registrations, only 9 of the identified marks are stylized registrations rather than design marks, and again, none of those registrations relates either to clothing or collegiate services. Again, they instead relate to entirely dissimilar goods and services.

Of the submitted registrations, there are only four that even involve Int'l Class 25, all design marks. Those are Registrations 0,506,143 (ball of yarn with letters SC inside); 2,210,480 (speeding racecar above the letters SC); 2,366,419 (Christian cross superimposed over the letters SC); and 2,599,410 (SC medallion for footwear). None of these marks can be confused with California's mark, and at least two of them involve quite different goods. Finally, as a matter of law, the mere citation to various registrations does not provide relevant evidence of actual dilution in the marketplace. TBMP § 704.03(b)(1)(B) n. 150 (citing cases).⁵

F. Carolina's Contention that the PTO Regularly Registers Stylized Collegiate Marks in the Face of Identical Pre-Existing "Typed Form" Marks Is Contradicted by the Registrations on Which It Relies.

In its conclusion, Carolina argues that there are numerous cases in which the PTO has registered a trademark for one collegiate mark in typed form and nevertheless allowed other various stylized examples. Carolina's own submission conclusively disproves this. While Carolina described various registrations as being in "typed form" or "stylized," review of the actual registrations reveals that none of the collegiate marks were registered in typed form, and almost none are even "stylized." Instead, virtually all of the identified registrations are design

⁵ Carolina also submits a printout of an ESPN website without any foundation. If considered, the website would at most demonstrate that ESPN's design mark that includes the letters SC might be infringing California's rights. However, the mere existence of one possible infringer does not deprive the trademark holder of its rights.

marks that include numerous visual elements other than the mere letters cited by Carolina.

Carolina's characterization of those registrations is flat wrong.⁶

III. Carolina's Legal Arguments Are Equally Misplaced

A. Carolina's Discussion of Outstanding Discovery Without Citing F.R.C.P. 56(f) Or Meeting Its Requirements Is Another Red-Herring

Carolina attempts to avoid summary judgment by noting that it has outstanding discovery requests to California. However, there is an established standard under Fed.R.Civ.P. 56(f) for addressing this situation, and Rule 56(f) requires more than just mention of an existing discovery request. TMEP § 528.06; *United States Olympic Committee v. O-M Bread, Inc.*, 29 USPQ2d 1555, 1556 n.3 (TTAB 1993). This standard is designed to avoid subjecting a party to "fishing expeditions" based on nothing more than a "speculative hope." *Brubaker Amusement Co. v. U.S.*, 304 F.3d 1349, 1361 (Fed. Cir. 2002). As a result, to invoke Rule 56(f), a party must submit an affidavit which demonstrates the specific discovery that would be sought and the reason to believe that the discovery would yield relevant information, and the failure to submit such an affidavit is not adequate under Rule 56(f). FRCP 56(f); TMEP § 528.06; *Keebler Co. v. Murray Bakery Prod.*, 866 F.2d 1386, 1389 (Fed. Cir. 1989). Not only has Carolina failed to submit an affidavit, it has not done anything that would meet the Rule 56(f) requirements. The discussion of Carolina's outstanding discovery is irrelevant.⁷

⁶ Moreover, even if there were examples in which a stylized collegiate or sports mark registered subsequent to an identical word mark, such a registration would not be precedential. The fact that an examiner may have inadvertently allowed a mark to register without any adversarial process does not provide precedent for repeating the inadvertent error. *In re Wilson*, 57 USPQ2d 1863, 1871 (TTAB 2001) (collecting cases showing that an examiner's error does not create a binding precedent.)

⁷ Carolina's allegation that California has "refused" to answer discovery is misleading since the discovery has never become due. See California's Opposition to Carolina's Mot. to Compel.

B. Carolina Cannot Avoid Evidence on How California Uses Its SC Mark

1. California's Citation to Its SC Registration In the Opposition Does Not Preclude Evidence of How California's SC Mark Is Used

In Opposition, Carolina contends that California did not plead common law uses of the SC mark and suggests that California should be precluded from relying on any evidence about how California uses its SC mark. Although never clearly articulated, Carolina suggests that this Board should ignore evidence of the specific forms of the mark (such as the "Baseball Interlock" and the "SC Interlock") as well as any evidence about the national extent of California's usage.

This is logically incoherent. California pled its SC word-mark registration because that registration was in typed form and therefore contained all possible stylized forms of the SC mark. Given the broad reach of the typed-form of the SC mark, it was unnecessary to burden this Board with an exhaustive pleading of all of the different forms of the mark used. Moreover, as noted above, at least the Baseball Interlock was automatically of record, since the file history of the 1,844,953 registration was automatically of record.

In addition, Carolina is wrong that California's Opposition somehow excludes common law uses. Although California did not use the words "common law," California specifically discussed its use of the SC mark in connection with various goods and services dating back to the late 1800s. [Opposition ¶ 2.] California further noted that its mark was famous and that it widely and extensively sells clothing and other products and services throughout the United States. [*Id.* at ¶¶ 6-7.] Given the short and plain pleading requirements, this is sufficient to include California's common law uses for the mark identified in the 1,844,953 registration.

Carolina was clearly aware of the breadth of California's common law usage, and the broad scope of its discovery requests reflect that awareness. *See Ex. A to Carolina's Motion to Compel, dated October 14, 2003.* Moreover, it is well established that a party may rely on

common law uses in opposing an application. *See generally* 15 USC § 1052(d) (registration may be refused on confusion with registered mark *or* mark in commerce). California has submitted undisputed and undisputable evidence that both parties market their goods nationally through many of the exact same retailers, and such evidence is sufficient to demonstrate the overlapping channels of trade.⁸

2. Even if California's Channels of Trade Were Limited, Carolina's Application Is Not Limited For Carolina's Channels of Trade

As a final point, California notes that Carolina's application is not limited in its channels of trade. As a result, even if California's channels were somehow considered limited to channels owned by California, Carolina's channels of trade would still overlap those of California.

C. The Lack of Evidence of Actual Confusion Is Irrelevant In This Case

Carolina notes the absence of any evidence about actual confusion and suggests that the Board consider the lack of such evidence as demonstrating the lack of any likelihood of confusion. First, as a matter of law, the lack of actual confusion does not demonstrate the lack of any likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165 (Fed. Cir. 2002). This is particularly true where, as here, the goods are low value goods and there is no reason to believe that confusion would necessarily result in any complaints reaching either party.

In evaluating the likelihood of confusion, the Board is not required to mechanically apply all the *duPont* factors as though each necessarily weighed on the case. Instead, the Board

⁸ Although California believes that its pleading is sufficient, there was no prejudice to Carolina in any ambiguity since Carolina has proceeded in this action as though California asserted common law claims. Moreover, there is no dispute about the extent of California's common law uses. To deny this motion on a pleading ambiguity would needlessly prolong this litigation as California would seek to amend under 37 CFR § 2.107 to clarify that it does rely on common law uses. The Board would thereafter be faced with this exact same motion.

identifies the relevant factors given the trademark application at issue, and may grant summary judgment where there is no issue of material fact on the relevant issues. *Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 332-33 (Fed. Cir. 1991). In this case, the presence or absence of actual confusion is not a relevant factor given the undisputed evidence on the other factors.

D. Carolina's Argument About "Discerning Consumers" Is Without Merit Given Its Lack of Support for Such a Claim

While Carolina contends that the consumers of these products are necessarily discerning, Carolina provides no evidence to support this claim. Although some alumni and fans may, in fact, be discerning consumers, other fans may not be so discerning and a whole class of entirely unsophisticated consumers may purchase these items as gifts for others. Carolina's only support for "discerning" fans comes from *Harlem Wizards v. NBA Properties*, 952 F.Supp. 1084, 1098 (D.N.J. 1997), which involved neither a trademark application nor similar entities marketing identical goods through identical retailers. Given the similar-to-identical nature of the marks, the identical nature of the goods, and the identical channels of trade, Carolina's assumption about "discerning consumers" cannot preclude summary judgment.

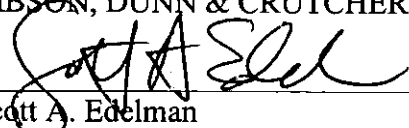
IV. CONCLUSION

For the reasons above, this Board should grant summary judgment.

Dated: December 10, 2003

Respectfully submitted,

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University of Southern California

Reference no. 93107-00125

Opposition No. 125,615

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **REPLY IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT** was placed in the United States mail, first class, postage pre-paid, addressed to the following on this 9th day of December, 2003.

John C. McElwaine
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Mary Robertson-Bora

CERTIFICATE OF EXPRESS MAILING UNDER 37 § CFR 1.10

I hereby certify that on December 9, 2003, the attached **REPLY IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT** (re Opposition No. 125,615) is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to:

BOX TTAB – NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202


Mary Robertson-Bora

ER266242881US
Express Mail Label Number

Enc. Postcard receipt
Reference no. 93107-00125

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Opposition No. 125,615

Serial No. 75/358,031

Mark: **SC (Stylized)**

Filed: September 16, 1997

Published: May 18, 1999

SUPPLEMENTAL DECLARATION OF ELIZABETH A. KENNEDY

IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT

I, ELIZABETH A. KENNEDY, declare as follows:

1. The facts set forth below are of my own personal knowledge unless otherwise indicated, and if called upon to testify, I would and could testify competently to those facts.

2. I currently hold the position of Director of Trademarks and Licensing Services for the University of Southern California ("Applicant" or "California"). I have held this position since October of 1988.

3. As part of my responsibilities as Trademark Licensing Director for the last decade and a half, I have been in charge of USC's management and enforcement of certain intellectual property rights, including those arising from its ownership of various federally registered trademarks ("California Registered Marks") and California trade names (collectively "California IP.") In this capacity, I have been involved in the prosecution of California's Registered Marks, including Federal Registration No. 1,844,953 for the SC word mark.

4. As part of the Statement of Use submitted to the United States Patent and Trademark Office, California submitted various photographs of items bearing the "Baseball Interlock" form of the SC mark. Although those items are already of record in this proceeding, I attach for the convenience of the Board copies of such photographs. Attached hereto as Exhibit A are true and correct copies of photographs submitted with the statement of use to the Patent and Trademark Office.

5. Through my involvement in the prosecution of California's Registered Marks, I am familiar with the history of the 1,844,953 registration. This involvement included involvement in discussions with Spelman College after Spelman College filed a request to extend time in which to oppose the application which ultimately registered as 1,844,953.

6. California did not make any modifications to its application as a result of the negotiations with Spelman College.

7. California *did* enter into a consent agreement with Spelman College for a specific design mark that bore little relationship to California's SC mark. The consent is limited to that specific design. The consent agreement does not cover any clothing or any goods in International Class 25. Attached hereto as Exhibit B is a true and correct copy of the consent agreement between California and Spelman College.

8. In addition to the fact that the mark was quite different and the goods and services were different, California felt that there was little likelihood of Spelman College marketing its goods beyond a small market. Spelman College was a small regional institution that did not even hold the lowest level of NCAA membership, and it appeared to California that Spelman College's goods and services would not only carry a highly distinctive mark but would also be marketed to a narrow class of consumers.

9. I am aware that the channels of trade in the application were narrowed before publication. This narrowing was done in response to the examiner's expressed concerns about a company known as "Snake Creek" which had a now-cancelled registration (attached hereto as Exhibit C) for an SC design mark. Snake Creek did not market clothing to the collegiate athletics market, and California narrowed its channels of trade in order to clarify that its registration would only apply to the collegiate athletics market.

10. As part of my experience as Trademark Licensing Director, I am naturally familiar with California's color scheme. I am also generally familiar with the color schemes used by various other NCAA Division I universities like Carolina (and I am particularly familiar with the color schemes used by Carolina).

11. California's color scheme is primarily cardinal and gold. Of those, cardinal is the primary color, and gold is typically the secondary color. However, in addition to those two colors, California frequently uses white and black as elements in California-related goods. The white and/or black can be used with either cardinal and gold together, or with just the cardinal or gold alone.

12. Carolina's color scheme is primarily garnet and black. Of those, it is my experience that garnet is typically the primary color for Carolina, and black is typically the secondary color. In addition to those two colors, I have seen Carolina goods which use white as an element of Carolina-related goods. The white can be used with both the garnet and black, or with just the garnet alone. (I have never seen any Carolina product with just black and white used as school colors).

13. Although garnet and cardinal sound different, they are both similar colors tending towards dark red. As a result, the primary colors for both Carolina and California are quite similar.

14. The confusing similarity is reflected in the goods for each school. For example, Carolina and California both market hats which have very similar color schemes in addition to their similar trademarks. I have recently encountered one example of this on the Internet retailer www.hatworld.com.

15. Attached hereto as Exhibit D is a true and correct copy of a California hat offered on the hatworld.com website. As the Board can see, it consists primarily of the SC logo on a dark red hat.

16. Attached hereto as Exhibit E is a true and correct copy of a Carolina hat offered on the hatworld.com website. As the Board can see, it too consists primarily of the SC logo on a dark red hat.

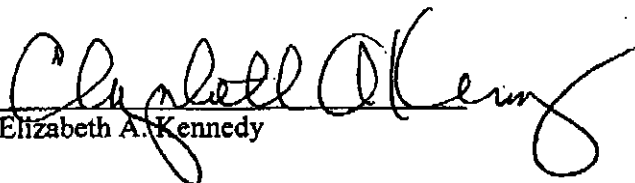
17. As part of my responsibilities as Trademark Director, I am also familiar with the logos that are used in connection with their football teams by various other NCAA schools like Carolina.

18. In my experience, Carolina uses its Carolina's traditional "C" mark which includes its Gamecock mascot in connection with its football team. I have reviewed the website maintained by the Carolina Athletic Department and found no example of any SC mark being used in connection with the football team. Instead, as the Board will see by reviewing Carolina's own site, Carolina's site reflects the usage of the traditional C with Gamecock mascot.

19. Attached hereto as Exhibit F for the convenience of the Board are true and correct printouts of pages from the Carolina Athletic Website dealing with the Carolina football team.

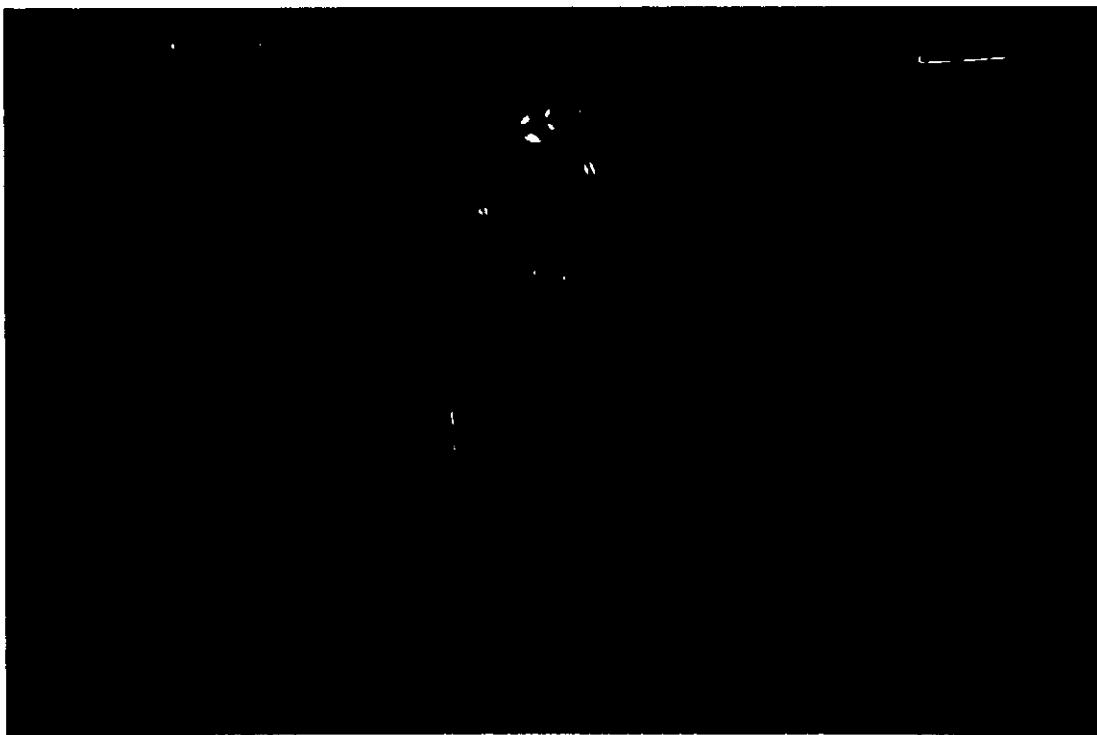
20. Finally, as part of my responsibilities as Trademark Director, I frequently visit various sporting goods stores that offer California merchandise. It is my experience that such stores more typically organize goods by type of good rather than by source of good. In other words, California's hats will frequently be organized with other hats, rather than organized with other California merchandise.

I declare that the foregoing is correct under penalty of perjury of the laws of the United States of America. Executed in Los Angeles, California on December 9, 2003.

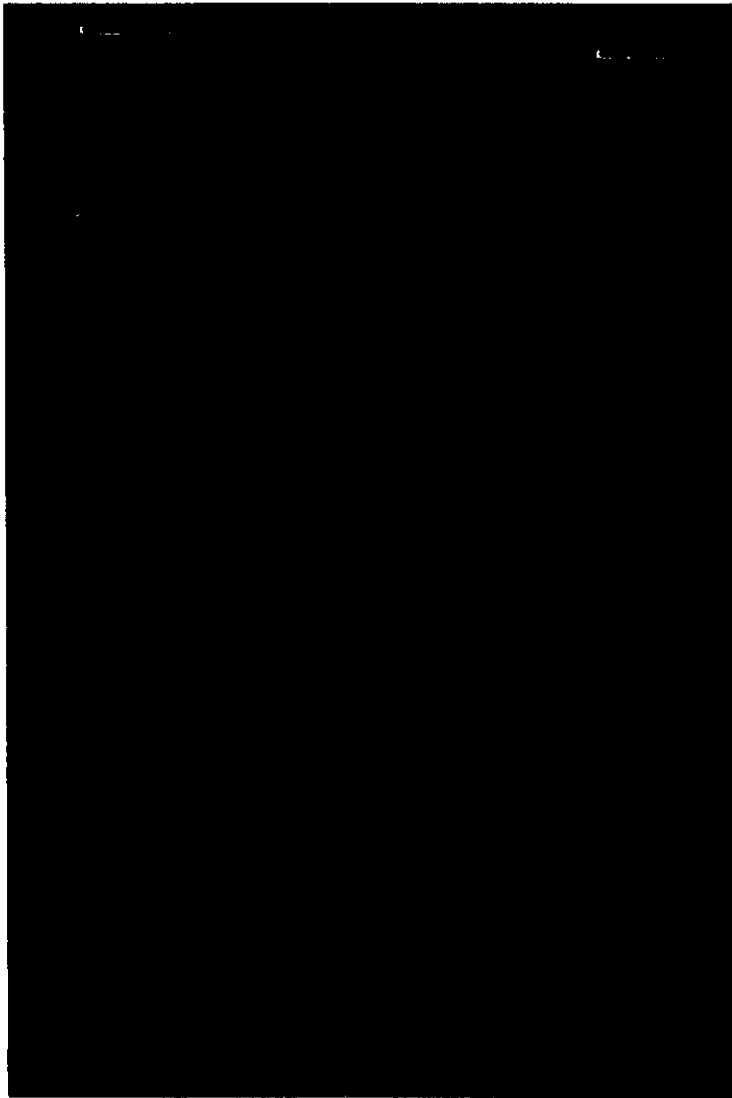

Elizabeth A. Kennedy

Reference no. 93107-00125

Opposition No. 125,615



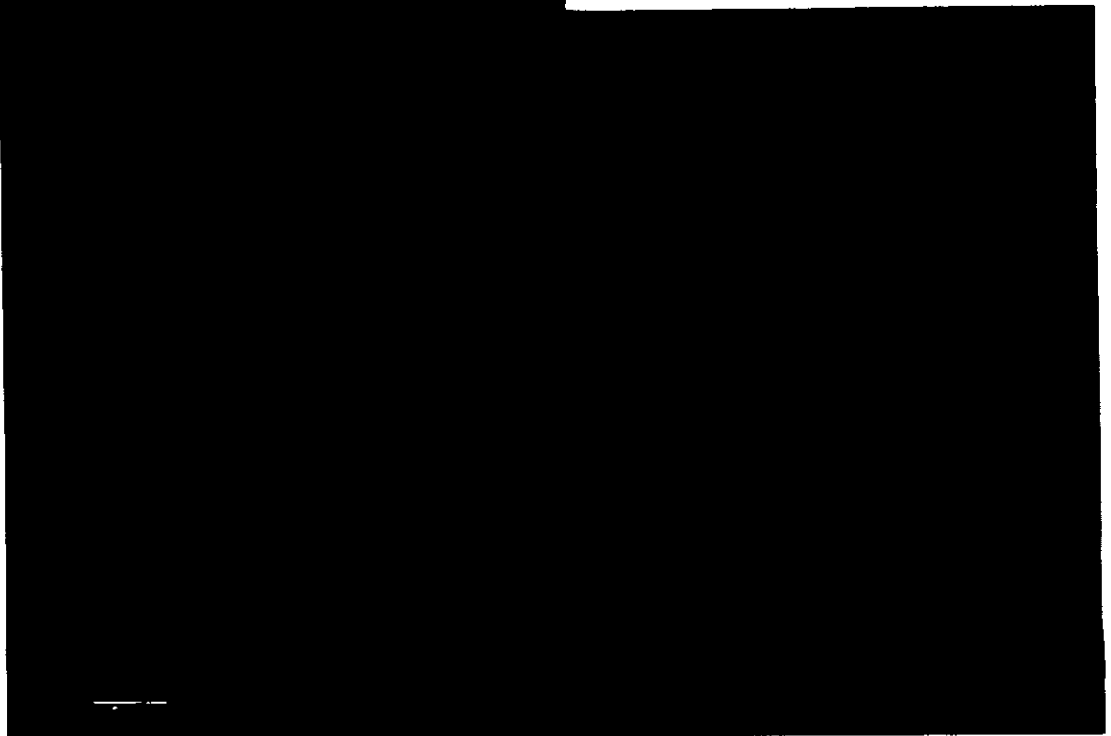
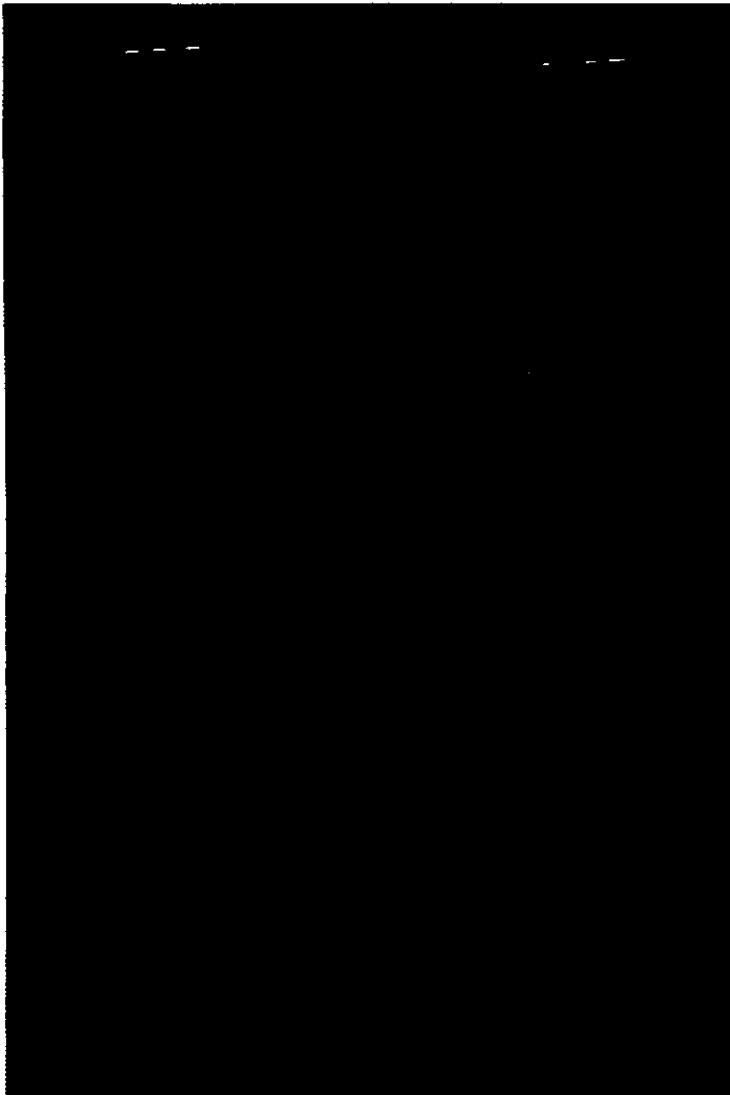
CLASS 2



CLASS 18



CLASS 24



CLASS 254



CLASS 25-2

AGREEMENT

THIS AGREEMENT, made by and between Spelman College, a Georgia corporation, having as its address 350 Spelman Lane, Atlanta Georgia 30314, and University of Southern California, a California corporation, having as its address University Park, Los Angeles, California 90089,

W I T N E S S E T H T H A T

WHEREAS, Spelman College asserts ownership in the United States of the trademark "SC (and schoolhouse design)", as depicted in the attached Exhibit A, for "alumni magazines" (in International Class 16); "college bookstore services" (in International Class 42); "educational services, namely providing courses of instruction at the college level" (in International Class 41); and "plastic shopping bags" (in International Class 18), and has filed Applications to register "SC (and schoolhouse design)" in the United States in International Class 16 (Application No. 74/338,417), in International Class 42 (Application No. 74/338,407), in International Class 41 (Application No. 74/338,414), and in International Class 18 (Application No. 74/338,579);

WHEREAS, University of Southern California asserts ownership in the United States of the trademark "SC" for "keyrings of non-precious metals, decorative emblems or plates of non-precious metal, for attachment to autos, art work statuary of non-precious metals, all goods being offered

and sold to persons through university authorized channels of trade" (in International Class 6); "umbrellas, hand luggage, tote bags, luggage, namely, tote bags, hand luggage, garment bags for travel, and small traveling bags for overnight trips, fanny packs, toiletry bags sold empty, briefcases, back packs, all goods being offered and sold to persons through university authorized channels of trade" (in International Class 18); "towels, blankets, cloth pennants and cloth flags, all goods being sold to persons through university authorized channels of trade" (in International Class 24); and "sweatshirts and t-shirts, all goods being offered and sold at university controlled outlets" (in International Class 25) and has filed an application to register "SC" in the United States in International Classes 6, 8, 24 and 25 (Application No. 74/094,681), which Application has been published for opposition at page 14-15 of the August 18, 1992 issue of the TM Official Gazette.

WHEREAS, Spelman College desires to have Trademark Applications Serial Nos. 74/338,417, 74/338,407, 74/338,414 and 74/338,570 for the trademark "SC (and schoolhouse design)" achieve registration;

WHEREAS, both parties desire to avoid any conflict between their respective marks and usage and desire to

continue selling their respective products under conditions that avoid likelihood of confusion;

NOW, THEREFORE, in consideration of the mutual promises and covenants contained herein, it is AGREED, CONTRACTED and COVENANTED as follows:

1. Spelman College agrees not to oppose University of Southern California's Application No. 74/094,681 to register "SC".
2. Conversely, University of Southern California agrees not to oppose Spelman College's applications Nos. 74/338,417, 74/338,407, 74/338,414 and 74/338,579 to register "SC (and schoolhouse design)".
3. Spelman College agrees not to use any registrations for "SC (and schoolhouse design)" that it obtains, or its other rights in the "SC (and schoolhouse design)" mark, to try to impede University of Southern California or its licensees from using any of University of Southern California's various "SC" designs, as depicted in the attached Exhibit B, on typical college bookstore merchandise.

4. Conversely, University of Southern California agrees not to use its "SC" registration, or its other rights in the "SC" mark, to try to impede Spelman or its licensees from using Spelman's "SC (and schoolhouse design)" logo on typical college bookstore merchandise.

5. If any of Spelman's pending Applications Serial Nos. 74/338,417, 74/338,407, 74/338,414, and 74/338,579 is refused on grounds of confusing similarity to the registration resulting from University of Southern California's Application No. 74/094,681, then University of Southern California will, upon request, sign a statement for Spelman College to file with the Patent and Trademark Office, saying that in University of Southern California's opinion there is no confusing similarity between the two marks.

6. The parties agree to avoid any advertising, promotion or marketing which would reasonably be expected to lead a substantial number of purchasers to erroneously believe that the parties' respective products emanate from the same source, and will take all necessary steps to remedy any confusion that may occur between the uses of their respective marks in the future.

7. The parties acknowledge and recognize that University of Southern California's "SC" mark and Spelman

College's "SC (and schoolhouse design)" mark do not currently conflict, and have not resulted in any actual confusion or likelihood of confusion in the past. Neither party foresees development of any such confusion or likelihood of confusion so long as neither party is in violation of this Agreement.

8. This Agreement shall be binding upon and inure to the benefit of the parties, their subsidiaries, affiliates, representatives, successors, assigns and anyone else claiming by and through any of the foregoing.

9. Any claim or controversy between the parties arising from or relating to this Agreement, or the breach thereof, shall be submitted to arbitration in accordance with the Commercial Arbitration Rules of the American Arbitration Association. The parties will each select an arbitrator from a list of qualified arbitrators provided by the American Arbitration Association. The selected arbitrators will then select a neutral third arbitrator, bringing the total to three (3) arbitrators. Each arbitrator shall be experienced in the field of trademark law, including practice before the U.S. Patent and Trademark Office. If no such individuals are included in the list of arbitrators provided by the American Arbitration Association, the parties may select any other individual meeting the qualification requirements of the American Arbitration Association rules. The parties may take

depositions and obtain discovery prior to the hearing in accordance with the provisions of the Federal Rules of Civil Procedure. The arbitrators may grant any remedy or relief which they deem just and equitable and within the scope of the agreement of the parties including, but not limited to, specific performance of the contract and permanent injunctive relief. The award of a majority of the arbitrators shall be binding and conclusive. A judgment confirming the award may be rendered by any court having jurisdiction thereof.

10. If any action to enforce the terms of this Agreement becomes necessary, the prevailing party shall be entitled to recover reasonable attorney's fees and other costs.

11. Any waiver by either party of any rights arising from breach of any provision of this Agreement shall not be construed as a continuing waiver of other breaches of the same or other provisions of this Agreement.

12. This Agreement constitutes the entire agreement between the parties with respect to the subject matter contained herein and supersedes all previous negotiations or proposals, and may only be modified by an amendment executed in writing by both parties hereto.

IN WITNESS WHEREOF, the parties have caused this Agreement to be executed in duplicate originals by their duly authorized officers as shown below. Each one of the duplicate executed originals is complete and valid by itself.

SPELMAN COLLEGE

UNIVERSITY OF SOUTHERN
CALIFORNIA

By: Robert D. Flanigan Jr
Robert D. Flanigan
Vice-President, Business
and Financial Affairs

By: Dennis J. Dougherty
Dennis Dougherty
Senior Vice-President
for Administration

Date: 2/15/93

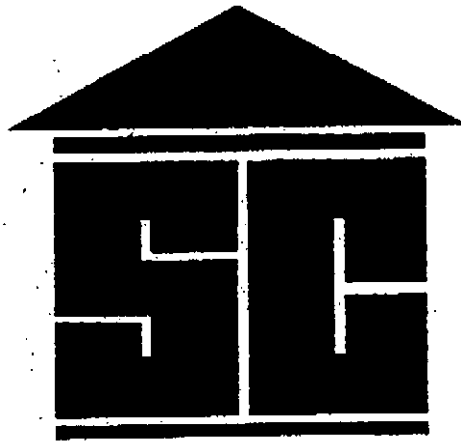
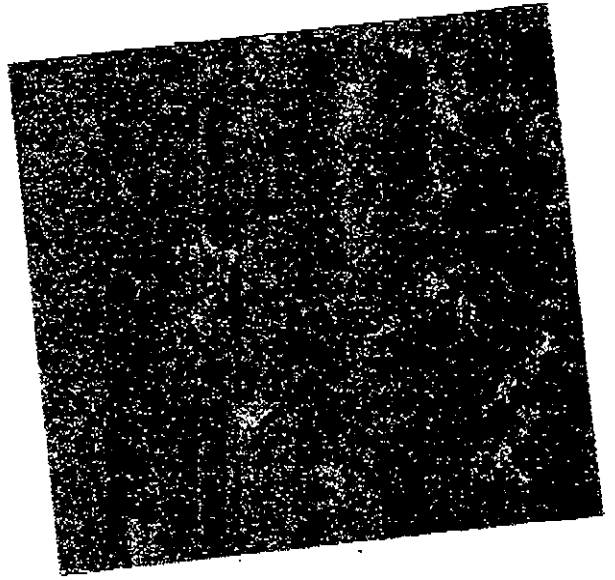
Date: 2/11/93

Place of
Execution: Atlanta, GA

Place of
Execution: Los Angeles, California

Attest: Mary L. Fakem

Attest: _____





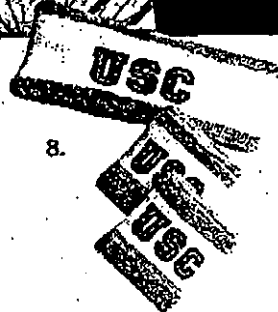
4. Bike cap. Designed to complement both casual and athletic wear. 100% cotton. One size fits all. From Kappit. \$5.00

5. Contemporary cardigan tee. This heavyweight cotton tee is versatile and fun. From Desert Sportswear. S, M, L, XL \$14.00

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an adjustable strap. From Kappit Specialty Co. \$13.00



AUTHENTIC ATHLETIC WEAR
These durable classics from Champion are popular year round. Short sleeve "property of" tee also available. Short features drawstring waistband and two on-seam pockets.

11. Grey "property of" tank. S, M, L, XL \$11.50 XXL \$13.75

12. Grey "property of" tee (not pictured). S, M, L, XL \$13.00 XXL \$15.25

13. Grey exercise shorts. S, M, L, XL \$19.50

8. Terry cloth wristband/headband set. One size fits all. From Devant Limited. \$5.50

9. Grey USC sweatshirt. This heavyweight crew is a campus necessity. Made of reverse weave cotton/acrylic/rayon knit for long-lasting wear. From Champion. S, M, L, XL \$40.50 XXL \$44.75

10. Ash grey tee. This comfortable lightweight 100% cotton tee is perfect for the traditional Trojan fan. From Collegiate Pacific. S, M, L, XL \$10.00





28.

28. Hair accessories gift set. Fun yet functional, this set includes a fabric covered barrette and a popular cardinal scrungie. From Let's Hair It. \$10.00/set

VERSATILE JUMBO TEES.
Get in the spirit of USC. Great as nightshirts or beach cover-ups. One size fits all.

29. USC Lucy shirt. Cotton/polyester blend. From Artex. \$21.50

30. White oversize tee. 100% cotton. From BJ Designs. \$15.00



32. Soft 10" foam football. From Scott Port-A-Fold. \$7.00

32.



33.

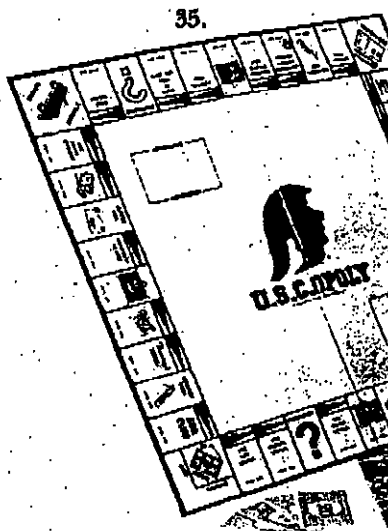


33. Sweater teddy bear. This soft white bear measures 12" high. From Abel Creations Company. \$15.00

34.



34. Mini 8 1/2" rubber football. From Baden Sports. \$11.00



35.

35. USCopoly. Begin at Registration and collect the most money and USC property while avoiding places like academic probation, car fines and increased tuition. From Late For The Sky Production Co. \$24.95

HISTORY OF USC FOOTBALL VIDEOS.
A collection of exciting football highlights and participants that have made USC football a proud tradition. VHS only. From Trojan Video Gold.

36. Volume I, The History of USC Football, 1888-1959. \$39.95

37. Volume II, The History of USC Football, 1960-1986. \$39.95

36.

38. Volume III, Crosstown: The USC-UGLA Rivalry! \$39.95

39. 3 Volume SET \$110.00

38. SPIRIT OF TROY: LIVE AND IN CONCERT.
Features USC Trojan Marching Band.

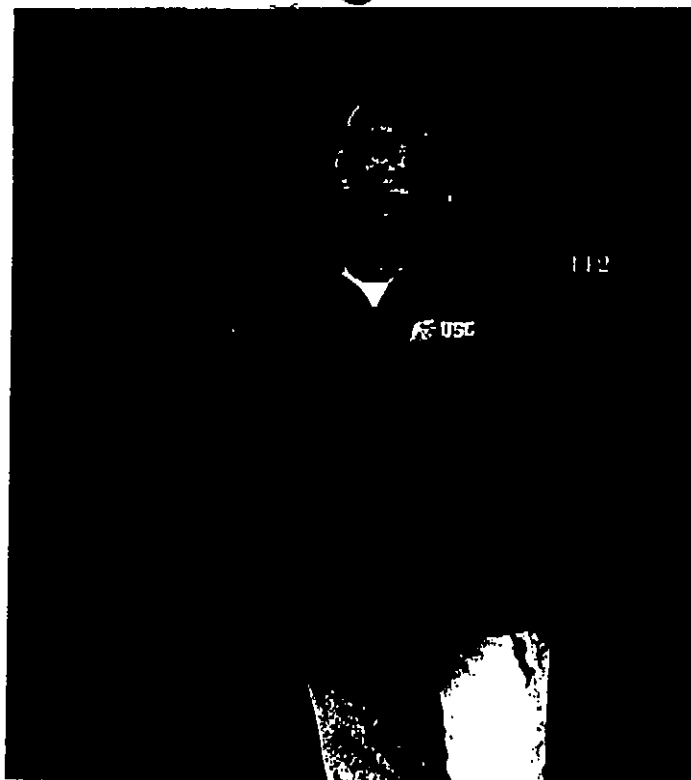
40. Album \$8.00

41. Cassette \$9.00

37.

40.





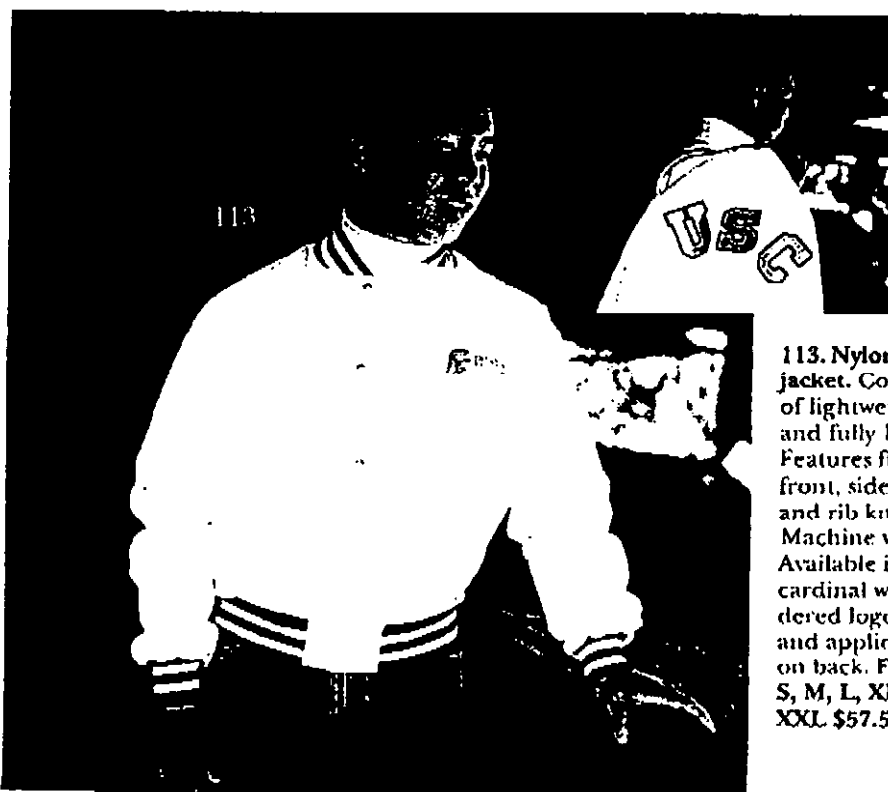
112. Pullover rainjacket. Lightweight jacket with drawstring hood and waist. Front Velcro closure pocket doubles as a pouch hand warmer. Features left chest embroidered logo. 100% nylon. Machine washable. From MVP. S, M, L, XL \$22.00, XXL \$26.50



Traditional letterman jacket. A timeless original that never goes out of style. 100% wool body, fully lined, leather sleeves and trim, chenille letters and rib knit collar and waistband. From Jostens College Division.

115. Men's S, M, L, XL \$135.00

116. Women's (not pictured)
S, M, L, XL \$135.00



113. Nylon baseball jacket. Constructed of lightweight nylon and fully lined. Features full snap front, side pockets, and rib knit collar. Machine washable. Available in white or cardinal with embroidered logo on front and applique letters on back. From MVP. S, M, L, XL \$53.50, XXL \$57.50

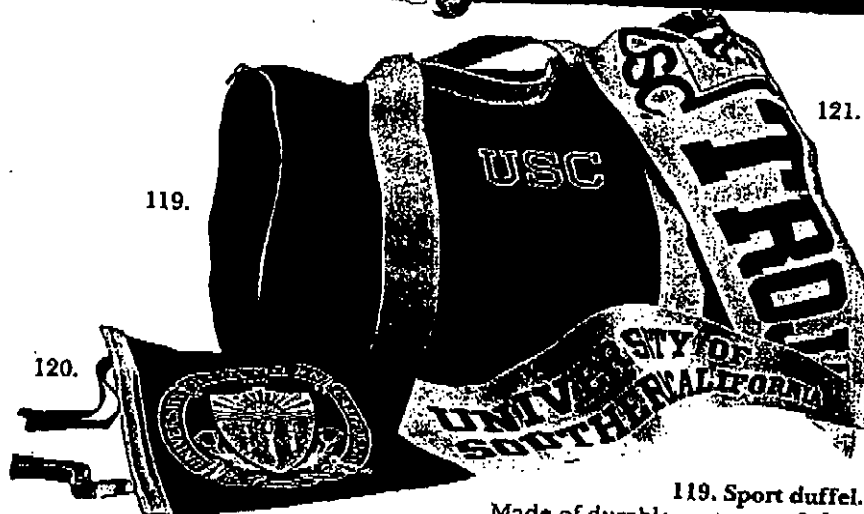
114. Mock turtleneck. A basic, in cool cotton with embroidered gold shield to coordinate with anything. From Crable Sportswear. S, M, L, XL \$20.00

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117. Wool baseball jacket.
Traditionally tailored and sophisticated, this high quality jacket is lined with soft quilting for warmth and comfort. Features an inside pocket and hidden full front zipper. 80% wool/20% nylon. Dry clean only. From Gear For Sports. S, M, L, XL \$119.95



119. Sport duffel.

Made of durable, waterproof Cordura, this 12"x20"x31" bag zips shut and contains a storage pocket for wet or soiled articles. Manufacturer's lifetime guarantee. Made in the USA. From Eastpak. \$34.50

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PENNANTS. 12" x 30" wool felt. From Collegiate Pacific East.

120. USC seal pennant. \$10.75

121. Trojan pennant. \$6.00

118. Cardigan sweater.
Updated styling highlights this classic collegiate sweater. Thick 100% cotton with two pockets and chenille letters. From Dehen Knitting. S(38), M(42), L(44), XL(48) \$69.95



118.



114.



Trojan Gift Collection

On the cover:

144. Birch grey hooded sweatshirt. Expertly manufactured with a lifetime guarantee on fabric and construction. Oversized, heavyweight, and 91% cotton for extraordinary softness and durability. Features drawstring hood, two on-seam pockets and sewn in side gussets to avoid shrinkage. From Russell Athletic. M, L, XL, XXL \$69.95. Supply is limited.

145. Maroon sweatshirt. A sophisticated look with gold embroidered accents on a puff print. Cotton/polyester blend. Machine wash, line dry. From Jansport. M, L, XL \$35.25.



Heavyweight sweats with double-stitched seams in a soft cotton/polyester blend. Features crewneck sweatshirt with set in sleeves and elastic/drawstring pants with buttoned rear pocket. From Gear For Sports.

146. Graphite sweatshirt. S, M, L, XL \$28.50 147. Graphite sweatpants. S, M, L, XL \$28.00

University of Southern California
Trojan Gift Collection
830 Childs Way, Suite 25
Los Angeles, CA 90007

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Current Filing Basis	1A
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Published for Opposition	October 14, 1980
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Registration Date	January 27, 1981
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Tailback Demetris Summers was named to The Sporting News' SEC All-Freshman team on Thursday. Offensive lineman Chris White was also selected to the squad.

12/4/03

Demetris Summers and Chris White Named To Sporting News All-SEC Freshman Squad

The Sporting News has chosen tailback Demetris Summers and offensive lineman Chris White to its 2003 SEC All-Freshman team. The announcement was made Thursday by the national publication. (more)

HIGHLIGHTS

2003 Award Candidates

- 2003 Statistics
- Weekly Release
- Depth Chart
- 2003 Outlook
- 2004 Football Schedule
- Lettermen's Reunion Weekend Brochure
- Get to Know Carolina
- Williams-Brice Stadium
- 2004 Football Camps
- Recruiting Questionnaire

12/2/03

Coach Holtz says his resolve is greater than ever to produce championship-caliber program at Carolina

No firm timetable set for hiring new assistants

11/23/03

USC Football Notes and Quotes

Lou Holtz says everything needs to be examined from top to bottom

11/22/03

Gamecocks Close Out Regular Season With 63-17 Loss To Clemson

South Carolina finishes season with a 5-7 record.

11/22/03

22 Seniors Say Farewell To Williams-Brice Stadium Tonight

11/20/03

Gamecock football practice report

On field preparations begin to wind down for Saturday's showdown

11/19/03

USC Football Practice Report

Gamecocks have spirited practice as game day draws nearer

**FEATURES**

- Football Feature: Travelle Wharton
- Football Feature: Rod Thomas
- Where Are They Now? Harold Green

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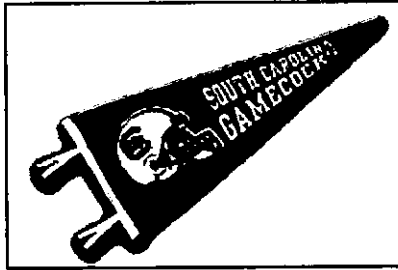
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **SUPPLEMENTAL DECLARATION OF ELIZABETH A. KENNEDY IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT** was placed in the United States mail, first class, postage pre-paid, addressed to the following on this 9th day of December, 2003.

John C. McElwaine
Matthew D. Patterson
Nelson Mullins Riley & Scarborough, L.L.P.
Liberty Building, Suite 500
Charleston, South Carolina 29401


Attorneys for Applicant University of South Carolina


Mandy Robertson-Bora

CERTIFICATE OF EXPRESS MAILING UNDER 37 § CFR 1.10

I hereby certify that on December 9, 2003, the attached **SUPPLEMENTAL DECLARATION OF ELIZABETH A. KENNEDY IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT** (re Opposition No. 125,615) is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to:

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Mandy Robertson-Bora

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